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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/630,493	07/30/2003	David Leigh Trigg	AA-541MC	9684

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EXAMINER

GEMBEH, SHIRLEY V

ART UNIT	PAPER NUMBER
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1614

MAIL DATE	DELIVERY MODE
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05/15/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/630,493

Applicant(s)

TRIGG ET AL.

Examiner

Shirley V. Gembah

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 January 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) 21-27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>4/20/05;2/07/05;10/27/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Information Disclosure Statement

The information disclosure statement (IDS) submitted on 10/27/2004, 2/07/2005 and 4/20/2005 have been received and acknowledged.

Response to restriction

Applicant's election of claims 1-20 in the reply filed on February 01/12/2007 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Status of claims

Claims 1-27 are pending.

Claims 1-20 are examined in this office action and claims 21-27 are withdrawn as to a non-elected specie.

Specification-Abstract

The abstract is objected to as it should contain no more than one paragraph (see MPEP 608.01 (b)).

Priority

Acknowledgment is made of applicant's claim for foreign priority based on an application filed in 10/630,483 on 7/30/03.

Claim Objections

The numbering of claim 1 is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. Claim

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1, should be renumbered in such a way that it is not confusing, for example under claim 1, should follow (a) and (b) and under those should be (i) (ii) and (iii). Appropriate correction is required.

Claim 1 is objected to because of the following informalities: the periods within the claim "1" and "2" are improper.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims **1-20** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "from about", "at least about" are not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, one of ordinary skill in the art would not be reasonably apprised of the scope of the invention, because one of skill will not be able to determine which term is in control. The claims lack clarity as to whether "from" (a lower limit) or "about"(broadening limitation, both higher and lower) controls the metes and bounds of the phrase "from about". Regarding "at least" (a lower limit) or about "(broadening limitation, both higher and lower) it is unclear what controls the metes and bounds of the phrase "at least about".

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims **1-11, and 17 -19** are rejected under 35 U.S.C. 103(a) as being unpatentable over Ha et al. US 5997887 taken with Jacquier US 6,337066 and Okamura EP 0063875 in view of Masuda et al. US 4, 076, 663 taken with Bengs et al. US 5,997,887.

Ha et al. teaches with regards to the instant claim 1 a liquid composition comprising a water insoluble substrate (see col. 18, lines 35-38 as a lipid or oily material-thus oils are hydrophobic in nature and is commonly known to one of ordinary skill in the art, reflective particulate material, wherein the reflective particulate has a particle size of 100 nm (see col. 3, lines 5-10), a water soluble thickening agent wherein

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the thickening agent is –xanthan gum as in claims 1 and 6 (see col. 11, lines 26-27), because xanthum gum is used as a non-gelling agent for controlling viscosity and has a very high –low sheer viscosity (as evidence by Zatz et al. see abstract) and is a polymeric thickening agent. As evidence by Zatz et al, viscosity of xanthan is 10^{-3} to 3.3×10^{-3} thus is within the claim limitation. Also, the Ha et al. reference teach with regards to the viscosity (1 cps = 0.001 Pa·s = 1 mPa·s), the viscosity of these thickening agent to be 50-70,00 cps, which is within the claim limitation having a viscosity of 1000mPa.s-700,000 (see col. 11, lines 40, 56-60 and col. 18 lines 65-67) wherein the aqueous carrier -water (see col. 5, lines 26-27), wherein the skin tone changing agent is about 0.01 %-2% (falls within the limitation of claim 2 (see col. 3, lines 6-8) having a particle size of 100 nm (see col. 3, line 8) as in claims 3 and 4 and the particulate material is a metallic oxide (see col. 3, line 15).

The reference also teaches the mask composition contains vitamin C (ascorbic acid (see col. 27, lines 63-64) and vitamin B₃ (see col. 25, lines 65-67) as in the current claim 8, a humectant (see col. 24, lines 1-2) as in the instant claim 9 as a moisturizing agent. One of ordinary skill in the art would have been motivated to add a humectant to the composition because it adds moisture to the skin, and does not leave the skin dry after the mask is removed. With regards to 5, the reference teaches starch is condensed with long chain alcohol resistant (see col. 19, lines 39-41), wherein the C8-30 having a sugar moiety (see col. 19, lines 40-42) connected via an ether linkage on the other end with a fatty alcohol to aid in dispersing the one phase (discontinuous) to the other phase (continuous) thereby been used as a dispersion characteristics. (Note

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this is a non-starch polysaccharide). Therefore one of ordinary skill in the art would have been motivated to use such a starch that would not only bind the components together but will also protect the face. The reference uses starch polymers (see col. 19, lines 39-41) such as glycosides. By definition resistant starch is defined as starch that does not absorbed in the small intestine. Note that polyglycosides s are formed by linking the carbohydrate moiety by $\alpha(1\rightarrow4)$ bonds. Therefore the starch used in the reference is a resistant starch (see explanation of a resistant starch above) (resistant starches are any starch that is not digested in the small intestine but passes to the large bowel for fermentation a non-starch polysaccharide (see abstract), as evident by Nils-Georg Asp (1987; vol. 9 (1) Abstract only) .

Jacquier, teach the use of resistant starch under the name resistamyl-E2 (see col. 2, line 42), in a cosmetic formulation for treating skin, therefore one of ordinary skill in the art would be motivated to use a resistant starch in a mask because it is used in a cosmetic formulation. One of ordinary skill in the art would be motivated to combine the teachings of Ha and Jacquier and use a resistant starch in a cosmetic formulation because Jacquier used a resistant starch in a cosmetic formulation., It is known to use a resistant starch in a cosmetic formulation.

Okamura teaches a cosmetic face mask- having a water- insoluble substrate-is made of a non-woven material (see page 5, lines 15-18) such as cotton yarn, synthetic etc as in claims 1 and 11. The reference also teaches a water insoluble substrate that is configured to cover majority of the facial area (see first page of the reference diagram) as in claims 17 and 19 as a single piece (see diagram). The reference also

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teaches (see page 7, lines 1-10) other agents or components that are included in the mask such as humectant. With regards to claim 18, the specific dimension was not taught but the reference teaches paper and ordinarily paper falls within the claim limitation of 18 (see pg. 5, lines 5-10).

Bengs et al., teach polysaccharides products in cosmetics (see col. 1, lines 22-50) wherein these polysaccharides have been used to treat skin to produce a pleasant feel (see col. 1, lines 49 and col. 10, lines 9-24). Note that Ha et al. teach the formation of these non-starch polysaccharides).

Although the Ha et al. reference did not teach the water insoluble substrate as cotton yarn, synthetic etc as in claims 1 and 11, one of ordinary skill in the art would have been motivated to substitute the oily or lipid base with that of Okamura, use the materials of Okamura based on the end product wanted by the one of ordinary skill in the art and combine with the teachings of Bengs et al. Okamura further teaches that these face masks can be used without washing the face and leaving flakes on the face (see page 7, line 20-30, they can be used to open sweat glands based on the material that is used (as a hot pack) and gives a high refreshing effect (see page 8, lines 1-20) and can be used for a wide range of applications. For example if the facial mask is used to unclog the pores, reduce puffiness, replace moisture back to the skin, therefore one of ordinary skill in the art would be motivated to use a facial mask that has a water insoluble substrate as cotton yarn, synthetic, that has embedded into it a liquid composition so that when applied to the face it adheres and dries and can be peeled off easily without making a mess or flakes to unclog pores, reduce swelling or puffiness

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and replace moisture. As evidenced by the cited prior art adding perfume to the composition as taught by Masuda et al. that perfumes when added will maintain their effects for a longer time when the resins are impregnated with them, especially with the use of agricultural product (see col. 5, line 65 bridging col. 6, lines 1-2). One of ordinary skill in the art would have been motivated to combine the above cited references and would have resulted in the claimed subject matter, because where Ha did not teach the resistant starch explicitly, was cured by Jacquier, both the Ha and Okamura teach humectant, and where Ha fails to teach a the water-soluble agent as a single piece was taught by Okamura.

Thus one of ordinary skill in the art would have been motivated to have a mask, comprising a water-insoluble substrate, a liquid composition a water –soluble thickening agent for consistency and an aqueous carrier for the reasons already addressed above.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to

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be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 1 – 15 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 - 13 of U.S. Patent Application No. **10622518**. Although the conflicting claims are not identical, they are not patentably distinct from each other. The reasons are as follows:

Both the claims of the co-pending applications and that of the instant application are to a mask composition, wherein the instant claims recite a mask composition comprising a hydrophobic –water-insoluble substrate which as explained above can be an oily substance, fabric, paper etc. a thickening agent, an aqueous carrier, The copending application recites A mask composition comprising:

- (1) a water insoluble substrate; and
- (2) an emulsified liquid composition comprising:
 - (a) an oily component;
 - (b) a hydrophilic surfactant;
 - (c) a water-soluble thickening polymer which provides the liquid composition a viscosity of from about 500mPa-s to about 60,000mPa-s; and
 - (d) an aqueous carrier. Since the term comprising is used the claims are interpreted as having the components that are missing in any one of the claims one of ordinary skill in the art would be motivated to modify the facial mask add or remove agent depending on the purpose.

The claims of the co-pending application is an obvious variation of the claims of the instant application.

In view of the foregoing, the copending application claims and the current application claims are obvious variations.

The Zatz reference is only used as evidence (abstract only enclosed)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shirley V. Gembah whose telephone number is 571-272-8504. The examiner can normally be reached on 8:30 -5:00, Monday- Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ardin Marschel can be reached on 571-272-0718. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

SVG
3/22/07

Ardin H. Marschel 5/13/07
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SUPERVISORY PATENT EXAMINER